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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,186	09/29/2003	Rudolph Nobis	END5212USNP	2665
27777	7590	01/22/2008		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER KASZTEJNA, MATTHEW JOHN	
			ART UNIT 3739	PAPER NUMBER
			MAIL DATE 01/22/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/674,186

Applicant(s)	Project	Amount	Comments

NOBIS ET AL.

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 and 22-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on October 18, 2007, amended claims 10 and 23 are acknowledged. The current rejections of the claims are *withdrawn*. The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-11, 14 and 22-26 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,643,653 to Takahashi et al.

In regards to claim 10, Takahashi et al. disclose a medical device comprising: a flexible member 14; an end effector 34 operatively associated with a distal end of the flexible member; and a handle 12 operatively associated with the proximal end of the flexible member; wherein the handle comprises an actuator 36 for operating the end effector through the flexible member (see Col. 5, Lines 65-75), wherein the proximal end of the flexible member is fixed relative to the handle, and wherein the flexible member extends from a single end of the handle (see Fig. 12); and wherein an outer surface of the handle is sized and shaped to be gripped by a single hand and wherein the actuator is disposed on

the handle. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In regards to claim 11, Takahashi et al. disclose a medical device wherein the end effector is selected from the group consisting of a biopsy forceps, grasping forceps, surgical scissors, extractors, washing pipes, needle injectors, non energized snares, and electrosurgical snares (see Col. 6, Lines 1-40).

In regards to claim 14, Takahashi et al. disclose a medical device wherein the handle has a proximal end, a distal end, and an outer surface, the handle outer surface having a maximum width dimension disposed intermediate the proximal and distal ends of the handle (see Figs. 1-2, 12 and 18).

In regards to claims 22-26, Takahashi et al. disclose a medical device comprising: a handle 12 adapted to be gripped by a single hand; an elongate, flexible member 14 extending from the handle, the flexible member having a proximal end and a distal end; and an end effector 18 operatively associated with a distal end of the flexible member; wherein the handle comprises an actuator 19, for operating the end effector through the flexible member, and wherein the actuator is adapted to be operated by the same hand holding the handle and without use of the thumb or index finger of the same hand; and wherein the handle comprises a release 36 operable by the thumb or index finger of the same

hand holding the handle (see Figs. 3 and 12, Col. 4, Lines, 1-10 and Col. 6, Lines 1-10). The words "for" and "adapted to" in the claims may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,643,653 to Takahashi et al. in view of U.S. Patent No. 5,624,379 to Ganz et al.

In regards to claims 12-13, Takahashi et al. disclose a medical device comprising: a flexible member 14 and an end effector operatively associated with a distal end of the flexible member but are silent with respect to wherein the flexible member is at least one meter long. Ganz et al. teach of an analogous endoscopic instrument wherein the flexible member is at least one meter long.

Moreover the length of the elongate member may vary according to its intended application (see Col. 3, Lines 30-35). It would have been obvious to one skilled in the art at the time the invention was made to construct a flexible member in the apparatus of Takahashi et al. of a length of at least one meter long to provide access to a variety of desired treatment sites deep within body lumen as taught by Ganz et al. and is well-known in the art.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,643,653 to Takahashi et al. in view of U.S. Patent No. 6,533,797 to Stone et al.

In regards to claim 15, Takahashi et al. disclose a medical device comprising: a flexible member 14 and an end effector operatively associated with a distal end of the flexible member but are silent with respect to wherein the actuator comprises a lever. Stone et al. teach of an analogous medical device wherein the actuator is a lever mechanism adapted to be squeezed and pivotably supported on an end of the handle (see Figs. 3-5). Thus Stone et al. demonstrate that the use of levers as actuators was well known in the art at the time the invention was made. It would have been obvious to one skilled in the art at the time the invention was made to use a lever actuator in the apparatus of Takahashi et al. to provide an alternate actuator providing greater comfort and maneuverability to the user as taught by Stone et al.

Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,643,653 to Takahashi et al. in view of U.S. Patent No. 6,443,944 to Doshi et al.

In regards to claims 16-20, Takahashi et al. disclose a medical device comprising: an end effector 34, handle 12; a flexible shaft 14 extending intermediate the end effector and the handle; the handle comprising: a housing adapted to be grasped by a single hand; an actuator 36 associated with the housing and operable by the hand holding the housing to actuate the end effector; wherein at least the thumb and index finger of the same hand holding the housing are free to grip and release the flexible shaft of the device (see Fig. 12 and Col. 5, Lines 65-75). It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The words "for" and "adapted to" in the claims may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use. The apparatus 2 is fully capable of being used with a single hand but Takahashi et al. are silent with respect to a set of instruction for using the handle with a single hand. In regard to claims 17-20, printed matter is given patentable weight only when a functional relationship exists between the printed matter and the substrate or element to which it is attached (see MPEP 2112.01(III)). *In re Ngai*, 70 USPQ2d 1862 (Fed. Cir. 2004). Furthermore, Doshi et al. teach of an analogous apparatus wherein the subject kits at least include a device of the subject invention and instructions for how to use the device in a procedure. The instructions are generally recorded on a

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suitable recording medium (see Col. 10, Lines 28-44). It would have been obvious to one skilled in the art at the time the invention was made to include a set of instructions with the apparatus of Takahashi et al. to insure proper usage of the apparatus as taught by Stone et al. and it is well-known in the art and considered obvious to include directions to any device.

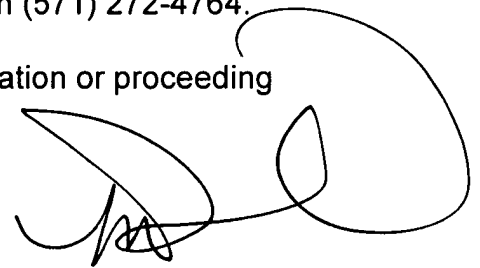
Response to Arguments

Applicant's arguments with respect to claims 10-20 and 22-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3700

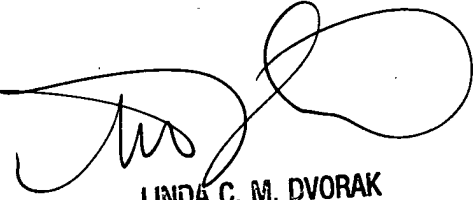
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MJK *ml*

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